

Serial No. 09/933,562

Atty. Docket No.: 58013.022800

Reply to Non-final Office Action mailed November 3, 2004

REMARKS

Claims 1-41, 43-46, 48-55, 57-59, 61 and 63-76 were pending in the present application. Claims 10, 42, 47, 56, 60, and 62 were previously canceled. Claim 26 has been amended. Therefore, claims 1-9, 11-41, 43-46, 48-55, 57-59, 61 and 63-76 are now pending in the present application.

Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 1-25, 43-46, 48-55, 57-59, 61, 74, and 75 are allowed.

Claim Objections

Claims 28-29, 34, 38-39, 41, 64-69, and 72-73 are objected to for depending on rejected base claims. Given the patentability of claim 1, Applicants are uncertain as to the basis for the Examiners objection of Claim 34. Applicants respectfully request that the Examiner withdraw the objection.

Claim Rejections

Claims 26-27, 30-33, 35-40, 63, and 67-71 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,364,504 to Hon. Claim 76 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hon and further in view of Jones et al. Applicants respectfully traverse these rejections for at least the following reasons.

Claims 26, 27, 30-33, 35 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hon. The Examiner asserts that "...Hon satisfies the limitation of the handle being cut out from a structure, since "structure" as recited in the claim is vague." (November 3, 2004 Office Action, Page 3). Applicants respectfully traverse the rejection. However, in an effort to expedite allowance of these claims, Applicants have amended independent claim 26 to remove the term "structure", and to more accurately represent the invention as described in paragraph [0040] of the specification. In particular, Applicants have amended claim 26 to better describe the cut out, hollow, or void portions of the handle, as described in paragraph [0040], and

Serial No. 09/933,562

Atty. Docket No.: 58013.022800

Reply to Non-final Office Action mailed November 3, 2004

as exemplified by elements 69 of Figure 2. Removal of these elements helps reduce the overall weight of the flashlight without sacrificing the structural integrity of the handle. Applicants' amendment having rendered the Examiner's rejection moot, Applicants respectfully request that the Examiner withdraw the rejection of Claim 26.

Claims 27-33, 35, and 36 depend from independent claim 26. The Court of Appeals for the Federal Circuit has consistently held that where a claim is dependent upon a valid independent claim, the independent claim is *a fortiori* valid because it contains all the limitations of the independent claim plus further limitations. See, e.g., Harness Intern. Inc. v. Simplimatic Engineering Co., 819 F.2d 1100, 1108 (Fed. Cir. 1987). Applicants assert that claims 27-33, 35, and 36 are patentable for at least the reasons recited above with respect to independent claim 26, and respectfully request that the Examiner withdraw the rejection of these claims.

With respect to claims 37 and 63, the Examiner asserts that "Hon discloses the claimed invention except for the recitation of 'the handle and barrel are ergonomically structured to promote balance in the flashlight.' With regards to this limitation, there is no structure recited in the claim to make this limitation distinguish over the prior art of reference, furthermore, reference numeral 20 of Hon teaches a tripod socket which enables the flashlight to be balanced on the base of the handle without tipping forward or backward which satisfies this limitation." (November 3, 2004 Office Action, Page 3). Applicants respectfully traverse the Examiner's assertion. Although it is true that Hon includes a tripod socket in the base of the handle, this does not imply that the Hon flashlight is ergonomically structured to promote balance, as recited in Applicants' claims. In fact, the fact that the Hon specification teaches that a tripod is necessary to balance the flashlight inherently teaches away from the ergonomically structured, balanced flashlight recited in Applicants' claims. As recited in Applicants' specification in paragraph [0051], "the flashlight with six batteries mounted in the barrel can balance to enable the flashlight to stand on a base of the handle without tipping forward or backward"; such balance obviates the need for a tripod. Clearly, the Hon reference teaches away from Applicants' claimed invention of an ergonomically structured, balanced flashlight. The Court of Appeals for the Federal Circuit has consistently held that it is "error to find obviousness where

Serial No. 09/933,562

Atty. Docket No.: 58013.022800

Reply to Non-final Office Action mailed November 3, 2004

references 'diverge from and teach away from the invention at hand'." In re Fine, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). Applicants therefore respectfully request that the Examiner withdraw the rejection of Claims 37 and 63.

Claims 38-39 depend from independent claim 37, and claims 64-69 depend from independent claim 63. The Court of Appeals for the Federal Circuit has consistently held that where a claim is dependent upon a valid independent claim, the independent claim is *a fortiori* valid because it contains all the limitations of the independent claim plus further limitations. See, e.g., Hartness Intern. Inc. v. Simplimatic Engineering Co., 819 F.2d 1100, 1108 (Fed. Cir. 1987). Applicants assert that claims 38-39 and 64-69 are patentable for at least the reasons recited above with respect to the independent claim upon which they depend, and respectfully request that the Examiner withdraw the objection to these dependent claims.

The Examiner rejected claims 40, 70, and 71, asserting that "Hon teaches the claimed invention except for the recitation of the barrel being substantially egg shaped from a forward end which the forward end is substantially truncated effectively creating a half egg shape to a rear end. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a half egg shape to the barrel of the housing of Hon since matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art." (November 3, 2004 Office Action, Page 3). Applicants respectfully traverse the Examiner's rejection. As described in the specification (see, e.g., paragraphs [0010], [0024], [0030], and [0039]), an embodiment of Applicants' invention allows for a watertight seal which, among other advantages, allows the flashlight to be used under water (see, paragraph [0050]). As will be appreciated by one skilled in the art, the egg shape provides a more aerodynamic and hydrodynamic design, thus reducing the amount of effort associated with transporting the flashlight, and reducing the impact of air and wind currents on the flashlight operator's ability to keep the beam pointed at the desired location. Clearly, the claimed egg shape design is more than an ornamental aspect of the housing. It is well established that, in order to show obviousness, all limitations must be taught or suggested by the prior art. In Re Boyka, 180 U.S.P.Q. 580, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03.

Serial No. 09/933,562

Atty. Docket No.: 58013.022800

Reply to Non-final Office Action mailed November 3, 2004

It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (CCPA 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (CCPA 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (CCPA 1973). Applicants therefore respectfully request that the Examiner withdraw the rejection of claims 40, 70, and 71.

Claim 41 depends from independent claim 40, and claims 72 and 73 depend from independent claim 71. The Court of Appeals for the Federal Circuit has consistently held that where a claim is dependent upon a valid independent claim, the independent claim is *a fortiori* valid because it contains all the limitations of the independent claim plus further limitations. See, e.g., Hartness Intern. Inc. v. Simplimatic Engineering Co., 819 F.2d 1100, 1108 (Fed. Cir. 1987). Applicants assert that claims 41, 72, and 73 are patentable for at least the reasons recited above with respect to the independent claim upon which they depend, and respectfully request that the Examiner withdraw the objection to these dependent claims.

The Examiner rejected Claim 76 under 35 U.S.C. §103(a) over Hon and further in view of U.S. Patent No. 6,053,623 to Jones et al. The Examiner asserts that, *inter alia*, "Jones discloses a reflective surface with substantially hemispherical protrusions." In fact, Jones teaches just the opposite. At column 8, lines 64-67, Jones teaches that "[a]ll of the facets 25a are more or less flat, except for manufacturing surface imperfections or distortions caused by discontinuities at the edges of any particular facet." Clearly, Jones does not teach or suggest a reflective surface with substantially hemispherical multiple protrusions, as recited in Applicants' Claim 76. It is well established that, in order to show obviousness, all limitations must be taught or suggested by the prior art. In Re Boyka, 180 U.S.P.Q. 580, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (CCPA 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (CCPA 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (CCPA 1973). Therefore, Applicants respectfully request that the Examiner withdraw the rejection of Claim 76. Applicants' distinguishing of claim 76 over the Jones reference should not be considered acquiescence to, or agreement with, the Examiner's characterization of the Hon reference and its

Serial No. 09/933,562
Atty. Docket No.: 58013.022800
Reply to Non-final Office Action mailed November 3, 2004

relationship to Applicants' claimed invention. Applicants respectfully reserve the right to file additional arguments in this regard.

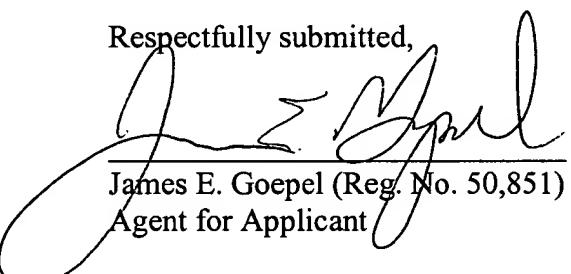
CONCLUSION

Applicants respectfully submit that all of the stated grounds of rejection have been properly traversed or rendered moot and believe that all pending claims 1, 4-13 and 16-20 are allowable over the prior art of record. Thus, it is believed that the present invention is in condition for allowance, and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of the application, he is courteously requested to contact Applicants' undersigned representative or Charles Berman at (310) 586-7770.

AUTHORIZATION

The Commissioner is authorized to charge any required fees associated with this paper, or credit any overpayment to **Deposit Account No. 50-0653**.

Respectfully submitted,


James E. Goepel (Reg. No. 50,851)
Agent for Applicant

GREENBERG TRAURIG, LLP
2450 Colorado Avenue
Suite 400 East
Santa Monica, CA 90404
(703) 903-7536
E-mail: goepelj@gtlaw.com

Filed: January 26, 2005